

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-20, 37, and 38 are pending in this application. Claims 1, 8, 15-20, 37 and 38 are amended by the present amendment. As amended Claims 1, 8, 15-20, 37, and 38 are supported by the original disclosure,<sup>1</sup> no new matter is added.

In the outstanding Official Action, Claims 1-5, 7, 15, 17, and 19 were rejected under 35 U.S.C. §103(a) as unpatentable over Yamagishi et al. (U.S. Patent No. 7,136,096, hereinafter “Yamagishi”) in view of Bender et al. (U.S. Patent No. 6,611,629, hereinafter “Bender”); Claim 6 was rejected under 35 U.S.C. §103(a) as unpatentable over Yamagishi in view of Bender and further in view of Miyatake et al. (U.S. Patent No. 6,466,262, hereinafter “Miyatake”); Claims 8-14, 16, 18, 20, 37, and 38 were rejected under 35 U.S.C. §103(a) as unpatentable over Yamagishi in view of Bender and further in view of Fukushima et al. (U.S. Patent No. 5,903,303, herein “Fukushima”).

With respect to the rejection of Claim 1 as unpatentable over Yamagishi in view of Bender, that rejection is respectfully traversed.

Amended Claim 1 recites, “said operation instruction signals include translation instructions input by a user to move a first image with respect to the image data obtained by said photographing unit for monitoring after the first image and the image data obtained by said photographing unit for monitoring are displayed by the display unit, said image data obtained by said photographing unit for monitoring being most recent image data measured by said photographing unit.”

Thus, in the invention recited in amended Claim 1, the display unit displays both a first image taken by the camera and the image data for monitoring (which is the most recent

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<sup>1</sup>See, e.g., the specification at page 11, lines 1-7.

image data measured by the photographing unit, i.e. the image data of what the camera is currently pointed at). The user can then input translation instructions to move the first image with respect to the monitoring image data. In one embodiment, the user then snaps a picture of the monitoring image to create a second image, which can then be combined with the first image.

The outstanding Office Action cited Figure 14B of Yamagishi as describing this feature with respect to Claim 21. However, Yamagishi describes an image processing apparatus 100 that does not include *any* operational instruction inputting unit which provides operational instruction signals including translation instructions, as conceded by the outstanding Office Action.<sup>2</sup> The outstanding Office Action cited Bender as describing this feature, asserting that Bender generally provides a motivation for translating images with respect to each other.<sup>3</sup>

However, Yamagishi describes a camera on that *automatically* correlates images to create a panorama. If the proposed modification were made, Yamagishi would no longer be suitable for its intended purpose, automatically making panoramic images. In this regard, *In re Gordon* holds that there can be no teaching or suggestion to make such a modification. (If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See MPEP §2143.01.)

Further, such a modification would change the principle of operation of the apparatus described in the primary reference, Yamagishi. *In re Ratti* holds that a combination requiring substantial reconstruction and redesign of the elements in the primary reference is not sufficient to render the claims *prima facie* obvious. (If the proposed modification or

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<sup>2</sup>See the outstanding Office Action at page 4, lines 15-20.

<sup>3</sup>See the outstanding Office Action at page 2, lines 12-14.

combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See MPEP §2143.01).

Therefore, it is respectfully submitted that none of Yamagishi, Bender, or Anderson et al. teach or suggest “wherein said operation instruction signals include translation instructions input by a user to move a first image with respect to ***the image data obtained by said photographing unit for monitoring*** after the first image and the image data obtained by said photographing unit for monitoring are displayed by the display unit, said image data obtained by said photographing unit for monitoring being most recent image data measured by said photographing unit” as recited in Claim 1, and there is no suggestion or motivation to combine the teachings of these references to create the claimed invention. Consequently, Claim 1 (and Claims 2-7 dependent therefrom) is patentable over Yamagishi, Bender, and Anderson et al.

With regard to the rejection of Claim 6 as unpatentable over Yamagishi in view of Bender and further in view of Miyatake, it is noted that Claim 6 is dependent from Claim 1, and thus is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Miyatake does not cure any of the above-noted deficiencies of Yamagishi and Bender. Accordingly, it is respectfully submitted that Claim 6 is patentable over Yamagishi in view of Bender and further in view of Miyatake.

As amended Claims 15, 17, and 19 recite similar elements to Claim 1, Claims 15, 17, and 19 are patentable over Yamagishi, Bender, and Anderson et al. for at least the reasons described above with respect to Claim 1.

With respect to the rejection of Claims 8, 16, 18, and 20 under 35 U.S.C. §103(a) as unpatentable over Yamagishi in view of Bender and further in view of Fukushima, it is

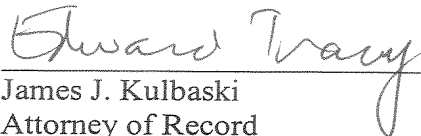
respectfully submitted that Fukushima also does not teach or suggest that “said operation instruction signals include translation instructions input by a user to move a first image with respect to *the image data obtained by said photographing unit for monitoring* after the first image and the image data obtained by said photographing unit for monitoring are displayed by the display unit, said image data obtained by said photographing unit for monitoring being most recent image data measured by said photographing unit,” as recited in amended Claims 8 and 20, “said operation instruction signals include translation instructions input by a user to move a first image with respect to *the image data obtained by said photographing means for monitoring* after the first image and the image data obtained by said photographing means for monitoring are displayed by the display means, said image data obtained by said photographing means for monitoring being most recent image data measured by said photographing means,” as recited in amended Claim 16, or “simultaneously displaying a first image and *image data obtained by a photographing unit for monitoring* on a display unit;” and “translating the first image with respect to *the image data obtained by said photographing unit for monitoring* after the first image and the image data obtained by said photographing unit for monitoring are displayed by the display unit, said image data obtained by said photographing unit for monitoring being most recent image data measured by said photographing unit” as recited in amended Claim 18. In fact, it is respectfully submitted that Fukushima does not teach or suggest operation instruction signals including translation instructions input by a user to move a first image with respect to any other image. In addition, it is respectfully submitted that there is no suggestion or motivation to combine Yamagishi and Bender, as noted above. Consequently, it is further respectfully submitted that amended Claims 8, 16, 18, and 20 (and Claims 9-14 dependent therefrom) patentably define over Yamagishi in view of Bender and further in view of Fukushima.

With respect to the rejection of Claims 37 and 38 under 35 U.S.C. §103(a) as unpatentable over Yamagishi in view of Bender and further in view of Fukushima, Claims 37 and 38 are amended to recite “said first image data obtained by said photographing unit for monitoring being most recent image data measured by a first CCD in said photographing unit and said second image data obtained by said photographing unit for monitoring being most recent image data measured by a second CCD in said photographing unit.” The outstanding Office Action indicated that such an amendment should overcome Yamagishi.<sup>4</sup> Therefore, Claims 37 and 38 are believed to be patentable over the cited references.

Accordingly, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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<sup>4</sup>See the outstanding Office Action at page 3, lines 5-9.